

application, and claims 41 and 55 as “unpatentable” over claim 7 of that application.

Claims 37, 38 and 42-52 stand provisionally rejected as “unpatentable” over claims 5-7, 43 and 44 of the ‘108 application in view of claims 1-18 of United States Patent 4,530,901.

Applicant requests that these double-patenting rejections be held in abeyance, given that prosecution of the ‘108 application has been suspended pending a final judgment in Interference No. 101,601. Particularly, applicant requests this action because the above-identified application is a pre-GATT application. Therefore, it is entitled to a 17-year term from date of grant. To now decide in which application particular claims are patentable would be potentially prejudicial to applicant’s rights.

Rejection Under 35 U.S.C. § 102(a)

Claims 37, 42-44, 46, 47 and 49 stand rejected under 35 U.S.C. § 102(a) as “anticipated” by Nagata et al., “Synthesis in E. coli of a Polypeptide with Human Leukocyte Interferon Activity,” Nature, 284, pp. 316-320 (1980) (“Nagata”).

Specifically, the Examiner asserts that “[t]he claims are embraced by the DNAs, vectors, and host cells of Nagata et al in that the claims also embrace DNAs that encode mature α -IFNs.” The Examiner also states that Nagata discloses the signal sequence for α -interferon. Applicant traverses.

Nagata is not a printed publication of “another.” Nagata lists nine individuals, including applicant, as co-authors. The other eight co-authors: Shigekazu Nagata, Hideharu Taira, Alan Hall, Lorraine Johnsrud, Michel Streuli, Josef Ecsödi, Werner Boll and Kari Cantell, are not inventors of the subject matter disclosed or claimed

in this application. As demonstrated by the Declaration of Charles Weissmann, submitted March 3, 1997 in co-pending patent application 08/475,869 ("the Weissmann Declaration") (copy attached as Exhibit A), applicant is the sole inventor of the subject matter described in Nagata and claimed in this application.

The Weissmann Declaration evidences that Shigekazu Nagata, Hideharu Taira, Alan Hall, Lorraine Johnsrud, Michel Streuli, Josef Ecsödi and Werner Boll worked at the Institut für Molekularbiologie I at the Universität Zürich in Zürich, Switzerland. Kari Cantell worked at the Central Public Health Laboratory in Helsinki, Finland. Although Dr. Weissmann's co-authors performed various experiments, they did so under his direction and control. They made no inventive contribution to the subject matter disclosed in the Nagata article. (See Weissmann Decl. ¶ 3.)

Thus, Nagata is not a proper § 102(a) reference against the subject matter of applicant's claims. See In re Katz, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982) ("one's own work is not prior art under § 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under § 102(a)"). In view of the facts set forth in the Weissmann Declaration, the rejection under 35 U.S.C. § 102(a) should be withdrawn.

Applicant has noted the Examiner's comments relating to formal drawings. Applicant will submit formal drawings upon notice of allowance of the pending claims.

CONCLUSION

In view of the above comments, applicant requests reconsideration of the pending claims.

Respectfully submitted,

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